

Remarks

Claims 1 to 14, 17 and 18 are currently pending and being considered in the present application. (Since claims 15 and 16 have been withdrawn from consideration).¹

Reconsideration is respectfully requested based on the following.

With respect to paragraph four (4) of the Office Action, claims 1 to 14 and 17 to 18 were rejected under 35 U.S.C. § 102(b) (the reference is not prior art under 35 U.S.C. § 102(b)) as anticipated by Taniguchi et al., U.S. Patent No. 7,212,989.

To reject a claim under 35 U.S.C. § 102, the Office must demonstrate that each and every claim feature is identically described or contained in a single prior art reference. (See *Scripps Clinic & Research Foundation v. Genentech, Inc.*, 18 U.S.P.Q.2d 1001, 1010 (Fed. Cir. 1991)). Still further, not only must each of the claim features be identically described, an anticipatory reference must also enable a person having ordinary skill in the art to practice the claimed invention, namely the claimed subject matter of the claims, as discussed herein. (See *Akzo, N.V. v. U.S.I.T.C.*, 1 U.S.P.Q.2d 1241, 1245 (Fed. Cir. 1986)).

As further regards the anticipation rejection, to the extent that the Office Action may be relying on the inherency doctrine, it is respectfully submitted that to rely on inherency, the Office must provide a "basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics necessarily flows from the teachings of the applied art." (See M.P.E.P. § 2112; emphasis in original; and see *Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Int'f. 1990)). Thus, the M.P.E.P. and the case law make clear that simply because a certain result or characteristic may occur in the prior art does not establish the inherency of that result or characteristic. Accordingly, it is respectfully submitted that any anticipation rejection premised on the inherency doctrine is not sustainable absent the foregoing conditions.

The Taniguchi reference concerns a vehicle-mounted communication device and a road-to-vehicle communication device which allow communication of information using a simple structure by making leakage of information difficult. Information including encryption information is communicated between an on-road apparatus having a memory in which an electronic key is stored, and a vehicle-mounted apparatus having a storage circuit. Encrypted route information is stored in the vehicle-mounted apparatus as is and

¹ The Office Action Summary incorrectly indicates that claims 15 and 16 are no longer pending. While claims 15 and 16 have been withdrawn from consideration, they have not been canceled.

encryption/decoding are executed at on on-road apparatus. Accordingly, the vehicle-mounted apparatus does not require encryption or decoding. (see abstract). However, the lack of encryption/decoding in the vehicle means that encrypted information cannot be “output” i.e. played back on radio, CD, DVD or other media player **inside the vehicle**.

In contrast, claim 1 provides for a method of outputting protected useful data in a vehicle. As explained in the specification at page 2, lines 4-28, usage authorization for the data *in the vehicle* is granted as a function of the road traveled or the area traveled. The system provides that a playback unit is coupled to a rights analysis unit, in which it is checked whether a location-dependent usage right exists for the encrypted useful data to be played back *in the vehicle*. For this purpose, a usage right, which permits the playback of the content only in the event of simultaneous usage of a specific road or a specific area and/or a defined group of roads, is transmitted together with or separately from the actual useful data, which is provided encrypted. The usage authorization is transmitted *into the vehicle*, so that the useful data may be decrypted and played back therein.

Accordingly, the Taniguchi patent does not identically describe the claim 1 feature for a “method of outputting protected useful data in a vehicle” as provided for in the context of claim 1, as presented, so that claim 1 is allowable.

Claims 2 to 14 and 17 to 18 depend from claim 1 and are therefore allowable for the same reasons. Accordingly, claims 1 to 14 and 17 to 18 are allowable.

Prompt consideration and allowance of the present application are therefore respectfully requested.

CONCLUSION


In view of the foregoing, it is respectfully submitted that all of the pending claims are allowable. It is therefore respectfully requested that the rejections (and any objections) be withdrawn. Prompt reconsideration and allowance of the present application are therefore respectfully requested.

Respectfully submitted,
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